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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,412	07/23/2003	John W. Norris III	AP35346-067834.0361	8142
21003 7590 06/19/2007 BAKER BOTTS L.L.P. 30 ROCKEFELLER PLAZA 44TH FLOOR NEW YORK, NY 10112-4498			EXAMINER SHANG, ANNAN Q	
			ART UNIT 2623	PAPER NUMBER
			MAIL DATE 06/19/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/625,412

Applicant(s)

NORRIS, JOHN W.

Examiner

Annan Q. Shang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 03/29/07 have been fully considered but they are not persuasive.

With respect to claims 1-17 rejected under 35 U.S.C. 103(a) as being unpatentable over **McKenna et al (2003/0005449)** and in view of **Herz et al (6,088,722)**, Applicant argues that Examiner "...has incorrectly rejected claims 1-17 without properly establishing a prima facie case of obviousness..." and further argues that the 103(a) rejection of claims 1-17 as being unpatentable over **McKenna** in view of **Herz** is improper (see page 8+ of Applicant's Remarks/Arguments).

In response, Examiner disagrees. Examiner notes Applicant's arguments, however, Examiner maintains that, the test for obviousness is not whether the features of a secondary reference may be bodily incorporate into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In this case **McKenna** discloses a distribution system 10 with a home base 12 which tracks the history of each site 18 to collect data and customizes schedule of services at anytime and delivers different digital entertainment content (DEC), to each site based on the history or survey or depending upon its needs (page 2, [0015] and [0028]). Furthermore, **McKenna** teaches that various guests, are first presented with an interactive schedule of services, containing textual or visual alerts and based on the responds received (history or

survey), the DEC is updated accordingly and at anytime (page 4, [0033]) to deliver the customized services to each site (page 3, [0028], [0030-0031]). McKenna is silent as to where the history or surveys, comprises at least one question to the user. However, in the same field of endeavor, this deficiency is disclosed in **Herz** (see figures 1-10), where Herz discloses a system and method for scheduling broadcast of and access to video programs and other data using customer profile(s), where profile(s) are generated from a survey of a plurality of questions to fill out and uses the profile(s) to target or customize content to user(s) in households or localities such as hotels (col.35, lines 6-16, col.39, lines 5-16, col.50, lines 22-28 and line 48-col.51, line 25),), as such combining the teaching of **Herz** with **McKenna** would be within the knowledge of one of ordinary skill in the art, and the motivation being to customize or target content to user(s) in a household or locality.

Furthermore it appears Applicant's arguments are directed against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. **See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).** Hence the 103(a) rejection is proper, meets all the claim limitations, maintained as repeated below. **This office action is made final.**

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **McKenna et al (2003/0005449)** and in view of **Herz et al (6,088,722)**.

As to claims 1-4, note the **McKenna** reference figure 1, discloses system and method for content delivery to lodging entertainment systems and further discloses a method and system for conducting a first survey (History of Hotel/Site 18-1) using a first interactive item selection system (interactive menu or schedule) displayed on a viewing surface of a first television (Guest Terminal or TV-54 of Hotel/Site 18-1), and for conducting a second survey (History of Hotel/Site 18-N) using a second interactive item selection system displayed on a viewing surface of a second television (TV-54 of Hotel or Site 18-N), comprising the steps of:

means for receiving or generating the first survey (Hotel/Site 18-1 generates a history or survey stored in Digital Content Receiver 'DCR' 44, page 2, [0018] and transmits to Home Base or Corporate Headquarters of digital entertainment Content system Vendor 'CH-DEC-Vendor' 12 'a central web server' or Uplink-Server/DMZ-34/40 of Uplink 14 'Uplink-14', which is coupled to System Server 22 for storing the history or survey, page 1, [0015-0018], and based on the history or survey, CH-DEC-Vendor 12 customizes schedule of services to each Hotel/Site 18N, page 3, [0026] and [0028-0030]) where the first survey is associated with at least one of a product (On-demand movies, Internet access, interactive video games, interactive services, etc., page 3, [0029-0030]) offered by a first entity (Hotel/Site 18-1) to a user (Guest) of the first interactive item selection system and a service performed by the first entity for the user

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of the first interactive item selection system (interactive menu or schedule system presented to guest by various remote Hotel/Site 18 or Processors in different geographical locations), note that CH-DEC-Vender 12 is a web server, coupled to remote Hotel/Site 18N and provides also web videos to various Hotel/Sites (page 4, [0034]);

receiving or generating the second survey (History of Hotel/Site 18-N) where the second is associated with at least one of a product offered by a second entity (Hotel/Site 18-N) to a user (Guest) of the second item selection system and a service performed by the second entity for the user of the second interactive item selection system, where the first and the second entity are separate entities (page 1, [0015-0016]), note that each Hotel/Site 18-1 to 18-N are located in many sites in different geographic locations;

storing (CH-DEC-Vendor 12 or Uplink-Server/DMZ-34/40 of Uplink-14, page 2, [0016-0018] and page 3, [0031-0032] the first and the second survey;

displaying (Hotel/Site 18N or Processor is configured to display on Guest Terminal or TV-54) a particular item (PPV, On-demand movies, internet access and other interactive services, page 3, [0029-0032]) of the first interactive item selection system on the viewing surface of the first television (Guest TV of Hotel/Site 18-1), where the particular item is associated with the first survey; displaying a further item of the second interactive item selection system of the viewing surface of the second television (Guest TV of Hotel/Site 18-N) where the further item is associated with the second survey; receiving an electronic request (Guest of Hotel/Site 18-1 interacts to purchase

or order the interactive service, using a series of interactive display menus, page 3, [0029-0031]) for the first survey when the user of the first interactive item selection system selects the particular item;

receiving an electronic request (Guest of Hotel/Site 18-N interacts to purchase or order the interactive service, using a series of interactive display menus, page 3, [0029-0031]) for the second survey when the user of the second interactive item selection system selects the further item;

displaying at least one portion of the first survey (Customized Schedule files, page 3, [0028-0030] for Hotel/Site 18-1) on the viewing surface of the first television after receiving the electronic request for the first survey; displaying at least one portion of the second survey (Customized Schedule files, page 3, [0028-0030] for Hotel/Site 18-N) on the viewing surface of the second television after receiving the electronic request for the second survey, note that the CH-DEC-Vendor or Uplink-Server/DMZ-34/40 of Uplink-14 transmits the customized schedule files to each Hotel/Site 18 and the Guest interacts with the customized schedule files to order or purchase a particular interactive service;

receiving (CH-DEC-Vendor 12 or Uplink-14, page 3, [0029-0032]) an electronic response to the first survey from the user of the first interactive item selection system (Hotel/Site 18-1); receiving an electronic response to the second survey from the user of the second interactive item selection system; and storing (CH-DEC-Vendor 12 or Uplink Server/DMZ-34/40 of Uplink 14) the response to the first survey and the response to the second survey of in a particular database (Server 22 of CH-DEC-Vendor 12 or Uplink

Server/DMZ-34/40 of Uplink 14, page 2, [0020-0023], note that CH-DEC-Vendor or Uplink-14 continuously checks the list to determine if any changes have been made to the list and response to the change of each specific Hotel/Site 18-1 to N and their Guest and attaches sites file to each DEC file in response to the interactive services to the various Guest within each Hotel/Site (page 2, [0022-0023]; page 3, [0028-003] and [0032-0033]).

McKenna fails to explicitly teach where the surveys, comprises at least one question to the user.

However, note the **Herz** reference figures 1-10, discloses a system and method for scheduling broadcast of and access to video programs and other data using customer profiles where the survey includes a plurality of questions to fill out to generate a profile of a user or and further applies the technique to hotel guest (col.35, lines 6-16, col.39, lines 5-16, col.50, lines 22-28 and line 48-col.51, line 25).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Herz into the system of McKenna to proper generate customer(s) profile and provide desired or targeted multimedia programs to the customer(s) or group of customers with similar taste or to customize or target content to user(s) in a household or locality.

As to claim 5, McKenna further discloses transmitting the first survey from the central web server (CH-DEC-Vendor 12) to the first processor (Hotel/Site 18-1) in a Hypertext Mark-up Language format, and where the step of transmitting the second survey from the central web server to the second processor includes the step

transmitting the second survey in the Hypertext Mark-up Language format (page 3, [0029] and page 3, [0034]).

As to claims 6 and 7, McKenna further discloses transmitting a particular message to a representative of the first entity or the second entity (Hotel/Site 18-1 to N) when at least one portion of the electronic response to the first survey corresponds to a particular predetermined response (page 3, [0031]).

As to claim 8, McKenna further discloses where the central web server (CH-DEC-Vendor 12) includes a first database (System Server 22), and a second database (Uplink Server/DMZ-34/40) located remote from the central web server and the processor (Hotel/Site 18N, page 1, [0015-0018]).

Claim 9 is met as previously discussed with respect to claim 1.

As to claims 10, the claimed "a system for conducting a survey using an interactive item selection system..." is composed of the same structural elements of previously rejected claim 1.

Claims 11-12 are met as previously discussed with respect to claim 1.

As to claim 13, McKenna further discloses a system comprising at least one server (Uplink Server/DMZ-34/40 of Uplink 14), which is coupled to CH-DEC-Vendor 12 and Hotel/Site 18N, such that CH-DEC-Vendor 12 is coupled to Hotel/Site 18N via Uplink Server/DMZ-34/40 of Uplink 14 (fig. 1 and page 1, [0015-0018]).

As to claim 14, McKenna further discloses where Hotel/Site 18N is located remote from the Guest TV-54 via Network 52 (page 2, [0018]).

Claim 15 is met as previously discussed with respect to claim 5.

Claim 16 is met as previously discussed with respect to claim 6.

As to claim 17, the claimed "a system for conducting a survey using an interactive item selection system..." is composed of the same structural elements of previously rejected claim 1.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

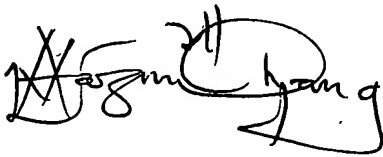
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Annan Q. Shang** whose telephone number is **571-272-7355**. The examiner can normally be reached on **700am-400pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Christopher S. Kelley** can be reached on **571-272-7331**. The fax phone

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number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the **Electronic Business Center (EBC)** at **866-217-9197 (toll-free)**. If you would like assistance from a **USPTO Customer Service Representative** or access to the automated information system, call **800-786-9199 (IN USA OR CANADA)** or **571-272-1000**.

A handwritten signature in black ink, appearing to read 'Annan Q. Shang', with a stylized flourish at the end.

Annan Q. Shang